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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,804	10/12/2001	Kouji Seino	1448.1016	7763

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EXAMINER
LASTRA, DANIEL

ART UNIT	PAPER NUMBER
3622	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	**Applicant(s)**
Office Action Summary	09/974,804	SEINO, KOUJI
	Examiner	**Art Unit**
	DANIEL LASTRA	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>27 November 2006</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>44,46-50,52-57,59-64,66-72,74-79 and 81-92</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>44,46-50,52-57,59-64,66-72,74-79 and 81-92</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>08/02/2006</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   Claims 44, 46-50, 52-57, 59-64, 66-72, 74-79, 81-92 have been examined.

Application 09/974,804 (METHOD OF AND APPARATUS FOR DISTRIBUTING

INFORMATION, AND COMPUTER PRODUCT) has a filing date 10/12/2001 and

foreign data 06/28/2001.

Response to Amendment

2.   In response to Non Final Rejection filed 05/24/2006, the Applicant filed an

Amendment on 10/24/2006, which amended claim 59. Applicant's amendment

overcame the Section 112 rejection.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 56, 71 and 86 are rejected under 35 U.S.C. 102(e) as being anticipated

by McCaskey (US 2002/0152245).

As per claims 56, 71 and 86, McCaskey teaches:

An apparatus for providing an electronic article stored in an article database to a

client computer connected to the apparatus via a network, the apparatus comprising:

a transmitting unit that transmits a summary of a plurality of electronic articles stored in the article database to the client computer (see paragraphs 21, 145; McCaskey col 17, claim 62),

a receiving unit that receives a specification from the client computer in response to the summary, the specification specifying which electronic article is selected by a user of the client computer (see McCaskey col 17, claim 62); an extracting unit that extracts a plurality of electronic articles from the article database based on the specification (see paragraphs 176-177, McCaskey col 17, claim 62);

a preparing unit that prepares an electronic mail based on the electronic articles extracted by the extracting unit (see paragraphs 176-179); and a transmitting unit that transmits the electronic mail prepared by the preparing unit to the client computer (see paragraphs 176-179; col 17, McCaskey claim 62).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 44, 46-50, 52-55, 57, 59-64, 66-70, 72, 74-79, 81-85 and 87-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCaskey (US 2002/0152245) in view of Reilly (US 5,740,549).

As per claims 44, 57 and 72, McCaskey teaches:

An apparatus for providing an electronic article stored in an article database to a client computer connected to the apparatus via a network, the apparatus comprising:

a transmitting unit that transmits a summary of a plurality of electronic articles stored in the article database to the client computer (see McCaskey paragraphs 21, 145, 176-179; McCaskey col 17, claim 62);

a receiving unit that receives a specification from the client computer in response to the summary, the specification specifying which electronic article is selected by a user of the client computer (see McCaskey paragraphs 176-177; McCaskey col 17, claim 62);

an extracting unit that extracts a plurality of electronic articles from the article database based on the specification (see McCaskey paragraphs 142-145; McCaskey col 17, claim 62);

a creating unit that creates a homepage based on the electronic articles extracted by the extracting unit and the advertisement extracted by the advertisement extracting unit and an uploading unit that uploads the homepage created by the creating unit to a predetermined website (see McCaskey paragraph 145);

an advertisement extracting unit that extracts an advertisement from an advertisement database (see McCaskey paragraphs 21,) but fails to teach based on the electronic articles extracted by the extracting unit. However, Reilly teaches a system that targets subscribers with headline news articles (see Reilly figure 6; col 13, lines 1-40) and upon said subscribers selection of those articles, presents said subscribers the full version of said articles with corresponding advertisements (see Reilly col 13, lines

60-67). Furthermore, <u>Reilly</u> teaches a system that broadcasts email messages containing news items to register subscribers (see <u>Reilly</u> col 16, lines 55-60). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that <u>McCaskey</u> would transmit electronic mails to subscribers, where said emails would contain summary of news (see <u>McCaskey</u> abstract) and upon said subscribers selection of articles in said summary, <u>McCaskey</u> would display a full version of said articles with corresponding advertisements, as taught by <u>Reilly</u> (see <u>McCaskey</u> paragraph 142) in a homepage in order to better target content and advertisements to said subscribers.

As per claims 46, 60 and 75, <u>McCaskey</u> fails to teach:

The apparatus according to claim 44, further comprising:

a number-of-times calculating unit that calculates a first number of times an advertisement is extracted from the advertisement database by the advertisement extracting unit, or a second number of times an advertisement is used for creating the homepage by the creating unit. However, <u>Reilly</u> teaches a system that calculates the number of times advertisements have been displayed in subscribers' computers in order to better target advertisements to said subscribers (see <u>Reilly</u> column 5, line 60 – column 6, line 10). <u>Reilly</u> does not expressly teach an accounting-fee calculating unit that calculates accounting fee incurred by an advertiser of an advertisement based on any one of the first number of times and the second number of times that correspond to the advertisement and are calculated by the number-of-times calculating unit. However, it would have been obvious to a person of ordinary skill in the art at the time the

application was made, to know that <u>Reilly</u> would use advertising display statistics for the

purpose of calculating advertisers' fees (see column 5, lines 53-60). Therefore, it would

have been obvious to a person of ordinary skill in the art at the time the application was

made, to know that <u>McCaskey</u> would calculate advertisers' fee for placing

advertisements in <u>McCaskey</u>'s website using the advertisements displayed statistics, as

taught by <u>Reilly</u> in order to better bill advertisers.

As per claims 47, 61 and 76, <u>McCaskey</u> teaches:

The apparatus according to claim 44, further comprising a website notifying unit

that notifies the website to which the homepage is uploaded by the uploading unit to the

client computer (see paragraph 78).

As per claims 48, 62 and 77, <u>McCaskey</u> teaches:

The apparatus according to claim 44, wherein the creating unit recreates the

homepage when any one of the electronic articles extracted by the extracting unit and

the advertisement extracted by the advertisement extracting unit is updated (see

paragraph 130; <u>McCaskey</u> col 17, claim 64).

As per claims 49, 63 and 78, <u>McCaskey</u> teaches:

The apparatus according to claim 48, further comprising a recreation notifying

unit that notifies the client computer that a recreation of the homepage has been

performed (see paragraphs 130, 145).

As per claims 50, 64 and 79, <u>McCaskey</u> teaches:

An apparatus for providing an electronic article stored in an article database to a

client computer connected to the apparatus via a network, the apparatus comprising:

a transmitting unit that transmits a summary of a plurality of electronic articles stored in the article database to the client computer (see paragraphs 21, 145 and 176-179);

a first receiving unit that receives a first specification from the client computer in response to the summary, the first specification specifying which electronic article is selected by a user of the client computer (see paragraph 176; McCaskey col 17, claim 62);

a first extracting unit that extracts a plurality of electronic articles from the article database based on the first specification (see paragraph 176; McCaskey col 17, claim 62);

a preparing unit that prepares an electronic mail based on the electronic articles extracted by the first extracting unit and the advertisement extracted by the first advertisement extracting unit (see column 2, lines 42-47; McCaskey col 17, claim 62);

a second receiving unit that receives a second specification from the client computer in response to the electronic mail prepared by the preparing unit, the second specification specifying which electronic article is selected by the user of the client computer (see paragraph 176; McCaskey col 17, claim 62);

a second extracting unit that extracts a plurality of electronic articles from the article database based on the second specification (see paragraphs 142-145);

a creating unit that creates a homepage based on the electronic articles extracted by the second extracting unit and the advertisement extracted by the second advertisement extracting unit (see paragraphs 142-145); and

an uploading unit that uploads the homepage created by the creating unit to a predetermined website (see paragraphs 142-145; McCaskey col 17, claim 63-64).

a first advertisement extracting unit that extracts an advertisement from an advertisement database and a second advertisement extracting unit that extracts an advertisement from the advertisement database (see paragraph 101) but fails to teach based on the electronic articles extracted by the first extracting unit and the second extracting unit. However, the same rejection made in claim 44 regarding this missing limitation is also made in claim 50.

As per claims 52, 67 and 82, McCaskey fails to teach:

The apparatus according to claim 50, further comprising:

a number-of-times calculating unit that calculates a first number of times an advertisement is extracted from the advertisement database by any one of the first advertisement extracting unit and the second advertisement extracting unit, or a second number of times an advertisement is used for any one of preparing the electronic mail by the preparing unit and creating the homepage by the creating unit. However, the same rejection applied to claim 46 regarding this missing limitation is also applied to claim 52.

As per claims 53, 68 and 83, McCaskey teaches:

The apparatus according to claim 50, further comprising a website notifying unit that notifies the website to which homepage is uploaded by the uploading unit to the client computer (see paragraph 130).

As per claims 54, 69 and 84, McCaskey teaches:

The apparatus according to claim 50, wherein the creating unit recreates the homepage when any one of the electronic articles extracted by the second extracting unit and the advertisement extracted by the second advertisement extracting unit is updated (see paragraph 101).

As per claims 55, 70 and 85, McCaskey teaches:

The apparatus according to claim 54, further comprising a recreation notifying unit that notifies the client computer that a recreation of the homepage has been performed (see paragraphs 130,145).

As per claims 59 and 74, McCaskey fails to teach:

The method according to claim 57, further comprising re-extracting another advertisement from the advertisement database when a display order of the electronic articles is changed at the client computer. However, Reilly teaches re-extracting another advertisement from the advertisement database when there is a changed in the display order of the electronic articles (see Reilly column 4, line 50 – column 5, line 7). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that McCaskey would display advertisements to subscribers based upon said subscribers selections of news articles, where said advertisements displaying order would be linked to the electronic articles displayed order, as taught by Reilly in order to target subscribers with advertisements based upon said subscribers selection of article in a summary of articles.

As per claims 66 and 81, McCaskey fails to teach:

The method according to claim 64, further comprising re-extracting another advertisement from the advertisement database when a display order of the electronic articles is changed at the client computer. However, the same rejection applied to claim 59 regarding this missing limitation is also applied to claim 66.

As per claims 87, 89 and 91, McCaskey fails to teach:

The apparatus according to claim 44, wherein a detailed level of the summary is determined by the user in advance. However, Reilly teaches determines the detailed level of displaying content in advance (see column 9, lines 35-60). Therefore, the same rejection applied to claim 44 regarding the obviousness of combining McCaskey with Reilly is also applied to claim 87.

As per claims 88, 90 and 92, McCaskey teaches:

The apparatus according to claim 44, wherein the specification further specifies whether a homepage is to be created or a electronic mail is to be prepared, and the creating unit creates the homepage when the specification specifies that a homepage is to be created (see paragraph 78).

Response to Arguments

5.   Applicant's arguments, filed 10/24/2006, with respect to the rejection(s) of claim(s) 44, 46-50, 52-57, 59-64, 66-72, 74-79, 81-92 under Reilly have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Reilly and McCaskey.
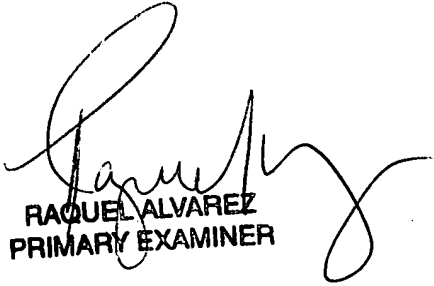
Conclusion

6.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Lastra
January 7, 2006

RAQUEL ALVAREZ
PRIMARY EXAMINER